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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,499	08/01/2001	Bobwen Zhont Kong	TESSERA 3.0-228	7119

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EXAMINER

UMEZ ERONINI, LYNETTE T

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/920,499	Applicant(s) KONG ET AL.	
	Examiner Lynette T. Umez-Eronini	Art Unit 1765	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-3, 5-9 and 31-36.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

NADINE G. NORTON
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments with respect to claims 1-3 5-9, and 31-36 4-8, 35, and 36 have been considered but have failed to place application in condition for allowance.

Applicants argue the combination of Walsh with the George reference fails to modify the dihydric alcohol to water ratio as claimed by Applicants. Applicants argument is unpersuasive because George teaches "It is within the knowledge of persons skilled in the art to control the extent of the etch by manipulating the parameters of concentration, time of exposure and temperature appropriate to the etchant selected" (column 3, lines 30-34), which is relied upon to show that the etching concentration and temperature are so-called result effective variables. Also, Applicants have also failed to specify the type (i.e. mole, volume, weight, flowrate, etc.) of ratio of said dihydric alcohol and said water.

Applicants argue Walsh fails to show an unexpected result such as and etch end point color signal, i.e., red when the amount of hydroxide base ranges from 40 - 80 grams per 100 ml of glycol/water and contact pad blistering when the ratio of glycol to water is less than 0.5:1 and about 8.5:1. In response to applicant's argument that the references fail to show certain features of applicant's invention, is noted that the features upon which applicant relies (i.e., etch end point color signal, i.e., red when the amount of hydroxide base ranges from 40 - 80 grams per 100 ml of glycol/water and contact pad blistering when the ratio of glycol to water is less than 0.5:1 and about 8.5:1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue the claimed etch composition is intended to form vias and through holes in a polymer substrate, which differs from the intended use of Walsh's etch composition. Applicants' argument is unpersuasive because no patentable weight is given to the phrase, "A composition for etching a polymer substrate . . ." Likewise the intended use of composition is not patentably significant. In *re Albertson* 141 USPQ 730 (CCPA 1964); In *re Heck* 114 USPQ 161 (CCPA 1957).